

REMARKS

1. The present amendment was necessitated by the new grounds for rejection by the Examiner, the rejections under 35 U.S.C. § 112. The Amendments to at least Claims 4 and 16 contain language that was present in the claims as filed and should not necessitate a new search by the Examiner. In addition, the amendments are believed to place the claims in better form for allowance or for appeal.

The application was filed with 27 claims. Claims 1-3 and 11-15 have been cancelled, and claims 28 and 29 have been added. Claims 4-10 and 16-29 are pending in the application. The Examiner is requested to withdraw the finality of the Office Action mailed on September 6, 2002. Reconsideration by the Examiner in view of the amendments and following remarks is respectfully requested.

2. The Examiner stated in the Office Action mailed on September 6, 2002 that Applicants' amendment of June 6, 2002 necessitated new ground(s) for rejection and hence made the Office Action final. Applicants traverse the finality of the Office Action. When new grounds for rejection are presented in an Office Action, it is appropriate to make the Office Action final only when each new ground for rejection is necessitated by Applicants' previous Amendment. M.P.E.P. 706.07(a). That has not occurred in this case. In particular, Claim 23 is presently rejected under 35 U.S.C. § 112, second para. However, in the previous Office Action, mailed March 28, 2002, Claim 23 was not rejected under § 112, second para. Since Claim 23 has not previously been amended, the new rejection based on § 112 was not necessitated by Applicants' amendment. Accordingly, the finality of the Office Action of September 6, 2002, should be withdrawn. The finality should be withdrawn for the added reason the new rejections of Claims 4, 16 and 24 under § 112, second para., regarding the phrase "lower jaw" were not necessitated by Applicants' amendment of June 28, 2002, since the phrases were present in the claims as filed. Applicants submit that the finality of the instant Office Action is therefore improper, and request that the Examiner withdraw the finality of the present Office Action, mailed on September 6, 2002.

3. In the Advisory Action mailed on November 20, 2002, the Examiner also noted that the Amendment mailed on November 6, 2002 by Applicants would not be entered. The Examiner is requested to enter the Amendment below.

4. The Examiner has rejected Claims 4-10 and 16-29 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which the Applicants regards as their invention. The Examiner has suggested four amendments. Applicants traverse the rejection to the extent the claims are clear to one of ordinary skill in the art. However, in order to expedite the prosecution of the present application, amendments to Claims 4, 16, 23 and 24 have been made in accordance with the Examiner's suggestions, to correct grammar. Applicants therefore request the Examiner to enter the Amendment, obviating the rejections under 35 U.S.C. § 112, second paragraph, and placing the claims in better form for allowance or for appeal.

Please note that amendments being made to claims 4, 16, 23 and 24 are being made to correct grammar and do not affect the meaning of the claims. Accordingly, the amendment being made to claims 4, 16, 23 and 24 are not being presented for reasons of patentability as defined in Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000).

5. The Examiner has rejected Claims 24 and 25 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Pat. No. 766,145 (July 26, 1904) to W. N. Greer ("Greer"). Greer does not anticipate the amended Claim 24 or Claim 25 because Greer does not describe a pivotable upper jaw, nor does Greer describe a brake lever that extends longitudinally the same length toward the gripping portion as the second portion of the lower jaw extends toward the gripping portion. Claim 24, and dependent Claim 25, recite a slide bar having a gripping portion, a pivotable upper jaw mounted to the slide bar, and a lower jaw, slidably mounted on the slide bar, the lower jaw having a first portion extending toward the upper jaw and a second portion extending in an opposite direction toward the gripping portion. Claim 24 also recites a brake lever, pivotally mounted on the lower jaw and spring-biased on the second portion of the lower jaw,

wherein a portion of the lever extends longitudinally and substantially the same length toward the gripping portion as the second portion extends longitudinally toward the gripping portion. Greer does not describe at least these limitations of Claim 24.

In order to anticipate an invention, the prior art reference must disclose every limitation of the invention. Since Greer does not disclose at least these limitations, Greer does not anticipate the claimed invention. Applicants therefore believe that the rejections under 35 U.S.C. § 102 (b) are overcome, and respectfully request the Examiner to withdraw the rejections under 35 U.S.C. § 102(b) of Claims 24 and 25 and to advance the claims to allowance.

6. The Examiner has made three separate rejections of claims under 35 U.S.C. § 103(a), over various combinations of references. Applicants respectfully traverse the rejections, since there is no suggestion to combine the references in each case. The Examiner states in the present Office Action that there is some teaching, suggestion, or motivation to combine the references, and that "some teaching, suggestion, or motivation is found in the references themselves as clearly set forth in the rejections." Office Action, p. 5, lines 11-13. Applicants have searched the rejections and can find no such teaching, suggestion or motivation, but only the conclusory statement that "it would have been obvious to one having ordinary skill in the art" to combine the references to arrive at the claimed invention.

The three primary references disclose contradictory teachings that cannot be combined neatly into the present claimed invention. Greer teaches that an object of his invention is to provide an improved mechanism "carried by the movable jaw to fix this jaw at an ascertained adjustment upon the shank of the wrench in cooperating position relative to the rigid jaw." W. N. Greer, U.S. Pat. No. 766,165 ("Greer"), col. 1, lines 12-16. The upper jaw need not be pivotable, as in the present claimed invention, but is described as "rigid," and is made even more rigid by the use of not a single bar, but two spaced members of the shank, as shown in Figs. 1 and 2. The two-member shank provides great stability against pivoting. Greer cannot be combined with any reference to yield an adjustable wrench with a pivotable upper jaw because Greer is designed with a rigid jaw that will not move or pivot.

H. Rhyn, U.S. Pat. No. 218,195 ("Rhyn"), teaches a pipe-wrench with a pivotable head and a spring for urging the pivotable head toward the object being wrenched. There is nothing else about Rhyn, however, that can be combined with Greer, because Rhyn teaches a pipe wrench with a very cumbersome adjustment. To adjust the lower jaw with head I or "biting jaw" as he terms it, requires cumbersome adjustment of the nut H shown in Figs. 1-3, "which may be turned to raise and lower the head." Rhyn states that an object of his pipe-wrench invention is "to prevent slipping from the pipe, insure a firm hold and ready operation, to preserve the operating-spring, and permit ready application to the pipe." Col. 1, lines 7-12. There is no statement or motivation here of any need for further improvement or to combine references.

B. M. Beesley et al., U. S. Pat. No. 2,54,824 ("Beesley"), teaches a pipe-wrench with a pivotable upper jaw, but without the convenient lower jaw and brake lever of the present invention. The Rhyn patent is in the list of art cited against Beesley (col. 6, line 39), who states that the prior art shows pipe wrenches "characterized by a screw adjustment and the parts are such that they are subject to becoming clogged," among other deficiencies. Col. 1, lines 9-13. There is no suggestion or motivation in Beesley that further improvements are needed. As mentioned above, Beesley cites the Rhyn patent in the references cited. Col. 6, line 39.

For a claim rejection 35 U.S.C. § 103(a), the Office Action, among other things, should provide an explanation of why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. M.P.E.P. 706.02(j). To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* The Office Action states that the references themselves contain such motivation or teachings, but Applicants are unable to find these passages. The Office Action has not provided this reference, and therefore, has not made a prima facie of obviousness for the instant rejections. It is therefore improper to reject the claims of the present application under 35 U.S.C. § 103(a).

7. The improperly combined references, properly interpreted, do not teach the claimed invention. The Office Action has rejected Claims 21-23 and 26-27 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Pat. No. 766,145 to W. N. Greer ("Greer") in view of U.S. Pat. No. 2,543,824 to B.M. Beesley et al. ("Beesley"). The Office Action states it would have been obvious to one having ordinary skill in the art to form the device of Greer with a pivotally mounted upper jaw with a spring and a ratcheting mechanism/ incremental teeth on the slide for engagement with the brake to allow the jaws to be adjusted to grip a workpiece as taught by Beesley.

Claim 21 has been amended to more particularly describe the hand tool contemplated to be used in the method of Claim 21, and its dependent claims. The amendment recites the additional limitations that the lower jaw has a lower portion extending toward a gripping portion of the hand tool, and that the brake lever is pivotally mounted on a portion of the lower jaw. The brake lever is further described in the amendment as having a portion that extend longitudinally and substantially the same length toward the gripping portion as the lower portion of the lower jaw extends longitudinally toward the gripping portion. As stated above, there is no motivation to combine the brake lever of Greer with the pivotable upper jaw of Beesley.

Even when combined, however, the references still do not teach the brake lever of the claimed invention, in which a portion of the brake lever extends longitudinally and substantially the same length toward the gripping portion as the lower jaw extends longitudinally toward the gripping portion. Claim 24 has also been amended, and thus Claims 26-27 are also amended, with limitations not described or suggested in the cited art. These limitations make clear that the upper jaw is pivotable and that the brake lever extends substantially the same in both directions as the second portion of the lower jaw. Applicants therefore believe that the rejections under 35 U.S.C. § 103 (a) are overcome, and respectfully request the Examiner to withdraw the rejections under 35 U.S.C. § 103(a) of Claims 21-23 and 26-27.

8. The Examiner has also rejected Claims 4-7, 16-17, and 29 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Pat. No. 766,145 to W. N. Greer ("Greer") in

view of U.S. Pat. No. 218,195 to H. Rhyn ("Rhyn"). The Office Action states that Greer discloses all of the claimed subject matter except for having a pivotally mounted upper jaw with a spring biasing the upper jaw toward the lower jaw, and that Rhyn discloses a pivotally mounted upper jaw with a spring biasing the upper jaw toward the lower jaw. The Office Action also states that it would have been obvious to one having ordinary skill in the art to form the device of Greer with a biasing spring as taught by Rhyn.

Combining these two devices, however, would not yield the present invention, because the pivot point of Rhyn is below the lower jaw of Rhyn's pipe wrench, and would thus also be below the lower jaw of the combination. Note also that the upper jaw of Rhyn is further bent at another point near the pivot point. The combination would be unworkable, and still would not have the longitudinally-extending brake lever of the present invention. Applicants therefore believe that the rejections under 35 U.S.C. § 103 (a) are overcome, and respectfully request the Examiner to withdraw the rejections under 35 U.S.C. § 103(a) of Claims 4-7, 16-17, and 29.

9. The Examiner has also rejected Claims 8-10, 18-20, and 28 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Pat. No. 766,145 to W. N. Greer ("Greer") in view of U.S. Pat. No. 218,195 to H. Rhyn ("Rhyn") and further in view of U.S. Pat. No. 2,543,824 to B.M. Beesley et al. ("Beesley"). The Office Action states that Beesley discloses a ratcheting mechanism/incremental teeth on the slide for engagement with the brake and gripping surfaces on the jaw. The Office Action also states that it would have been obvious to one having ordinary skill in the art to form the device of Greer with a ratcheting mechanism/incremental teeth on the slide for engagement with the brake and gripping surfaces on the jaw to allow the jaws to be adjusted to grip a workpiece as taught by Beesley.

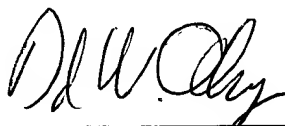
Even combined, the references do not yield the invention claimed in Claims 8-10, 18-20 and 28. Combining Greer and Beesley is contradictory, since Greer teaches an upper jaw that is not only fixed, but fixed with two solid members such that no rotation or movement is possible or contemplated. The Office Action does not point out how the two-member shank of Greer will be altered to accommodate the ratcheting

mechanism/incremental teeth of Beesley, or how or where the pivot point will be placed. It is improper to use only part of a reference if the exclusion of other parts is necessary for a full appreciation of what the reference teaches. M.P.E.P. 2141.02, at 2100-120 (stating that the prior art must be considered in its entirety, including disclosures that teach away from the claimed invention); see *also* Bausch & Lomb, Inc. v. Barnes-Hind Hydrocurve, Inc., 230 U.S.P.Q.416, 419 (Fed. Cir. 1986).

Applicants therefore submit that the rejections of Claims 8-10, 18-20, and 28 under 35 U.S.C. § 103 (a) are overcome. The Examiner is respectfully requested to withdraw the rejections under 35 U.S.C. § 103 (a) of Claims 8-10, 18-20 and 28.

10. Applicants have amended claims, primarily for better grammatical expression. No new matter has been added in amending claims. Applicants have traversed the rejections and respectfully request that the Examiner withdraw the finality of the Office Action, withdraw rejections under 35 U.S.C. §§ 102 and 103, and advance the application to allowance. Should the Examiner believe that contact with the undersigned will expedite the allowance of the claims, the Examiner is respectfully asked to call the undersigned at 312-321-4711.

Respectfully submitted,



Michael P. Chu
Reg. No. 37, 112
David W. Okey
Reg. No. 42,959
Attorneys for Applicant

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200

APPENDIX A

These claims have deleted portions in brackets and added portions underlined.

4. (Amended twice) An adjustable pipe wrench, comprising:
a slide bar having a gripping portion;
an upper jaw mounted pivotally to the slide bar and [mounting] a spring mounted
between the upper jaw and the slide bar;
a lower jaw, slidably mounted on the slide bar, said lower jaw having a lower
portion extending toward the gripping portion; and
a brake lever, pivotally mounted on a portion of the lower jaw and spring-biased
against said lower jaw wherein a portion of the lever extends longitudinally, and
substantially the same length toward the gripping portion as the lower jaw extends
longitudinally toward the gripping portion, and wherein a user may adjust a position of
the lower jaw on the slide bar by actuating said lever and moving said lower jaw relative
to said slide bar.

16. (amended twice) An adjustable hand clamp, comprising:
a slide bar having a gripping portion;
an upper jaw mounted pivotally to the slide bar and [mounting] a spring mounted
between the upper jaw and the slide bar;
a lower jaw, slidably mounted on the slide bar, said lower jaw having a first
portion extending toward the upper jaw and a second portion extending in an opposite
direction toward the gripping portion; and
a brake lever, pivotally mounted on one of said portions of the lower jaw and
spring-biased against said second portion of the lower jaw, wherein a portion of the
lever extends longitudinally, and substantially the same length toward the gripping
portion as the lower jaw extends longitudinally toward the gripping portion, and wherein
a user adjusts a position of the lower jaw on the slide, by repositioning the lower jaw
with a thumb.

21. (Amended twice) A method of grasping an object with one hand using an adjustable hand tool having a brake lever, the method comprising:

providing the object and the hand tool;

gripping the hand tool with one hand;

adjusting a gap between jaws of the hand tool with the same hand, using a lower jaw and a pivotable upper jaw of the hand tool, wherein the lower jaw has a lower portion extending toward a gripping portion of the hand tool, and the brake lever of the hand tool is pivotally mounted on a portion of the lower jaw, and wherein a portion of the lever extends longitudinally, and substantially the same length toward the gripping portion as the lower portion extends longitudinally toward the gripping portion; and grasping the object.

23. (Amended) The method of Claim 21, further comprising tightening a grasp on the object, urging [a pivotally-mounted] the pivotable upper jaw and a moving lower jaw to grasp the object more tightly, wherein the hand partially rotates the hand tool about the object and presses the lower jaw toward the upper jaw.

24. (Amended twice) An adjustable pipe wrench, comprising:

a slide bar having a gripping portion;

[an] a pivotable upper jaw mounted to the slide bar;

a lower jaw, slidably mounted on the slide bar, said lower jaw having a first portion extending toward the upper jaw and a second portion extending in an opposite direction toward the gripping portion; and

a brake lever, pivotally mounted on the lower jaw and spring-biased on [a] the second portion of the lower jaw, wherein a portion of the lever extends longitudinally, and substantially the same length toward the gripping portion as the [lower jaw] second portion extends longitudinally toward the gripping portion, and wherein the brake lever and the slide bar form a bar-engaging mechanism, and a user may open the jaws with a thumb, disengaging the brake lever from the slide bar and urging the lower jaw away from the upper jaw.